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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/465,708	12/17/1999	FUMIKO SEMBA	FUJI-16.863	9208
26304	7590	01/27/2004		
KATTEN MUCHIN ZAVIS ROSENMAN 575 MADISON AVENUE NEW YORK, NY 10022-2585			EXAMINER AL AUBAIDI, RASHA S	
			ART UNIT 2642	PAPER NUMBER 21
DATE MAILED: 01/27/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/465,708

Applicant(s)

SEMBA ET AL.

Examiner

Rasha S AL-Aubaidi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12/16/2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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***Response to Amendment***

1. This is responsive to amendment filed 12/16/2003. Claims 1-10 have been canceled. Only claims 11-13 are currently pending. This is a non-final office action.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farris et al (US Patent 6,574,216).

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Regarding claim 11, Farris specifically teaches the switching of the telephone call in progress, and currently connected via the Internet (50, Fig. 3) to another non-internet network (PSTN 10, Fig. 3) in order to **improve voice quality**. See abstract, col. 9, lines 35-58 and col. 11, lines 22-58. The claimed "exchange" reads on the combination of SSP 13 and Internet module 92. All the claimed "parts" are in Farris because it performs all the claimed limitations. Pressing the "\*" digit on the caller's telephone 11 during an economical Internet call will switch the call from Internet 50 to the PSTN 10 to improve the voice quality. The Internet may be selected when the caller dials a code such as \*82 or based on the caller's routing criteria in his/her CPR (col. 9, lines 35-58).

Farris differs from the claims only in the way the caller signals his/her desire to switch from the Internet to PSTN during a telephone call via the Internet. In Farris, the caller signals his/her desire to switch from the Internet to PSTN by dialing the "\*" digit which is detected by Internet module 92 during a telephone call via the Internet. However, in the claimed invention, the caller signals his/her desire to switch from the Internet to PSTN by pushing a button after a "quick" on-hook/flash operation during a telephone call via the Internet.

The difference is merely in the specific way the caller signals the exchange ("SSP 13 and module 92"). The use of on-hook/flash operation to signal an exchange is old and well known. For example, a quick or temporary on-hook or flash operation maybe used to establish a conference call, to answer a call in response to a call waiting tone ... etc. Thus, obviously one of ordinary skill in the art may use any type of signal ("\*" in Farris, or pushing a button after a flash operation in the claims) in order to

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accomplish the same exact result for the same exact purpose. Simply using another signal in Farris does not rise to the level of patentability.

Claims 12-13 are rejected for the same reasons as discussed above with respect to claim 11.

### ***Response to Arguments***

4. Applicant's arguments filed 12/16/2003 have been fully considered but they are moot in view of the new ground of rejection.

### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rasha S AL-Aubaidi whose telephone number is (703) 605-5145. The examiner can normally be reached on Monday-Friday from 8:30 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ahmad F Matar, can be reached on (703) 305-4731. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9314.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

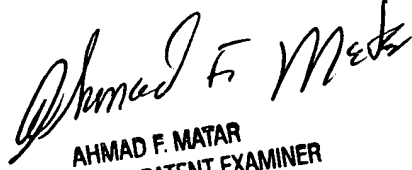
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Examiner

Rasha S. al-Aubaidi

01/21/2004

  
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